

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant: Aristidou et al. Conf.: 6884
Appl. No.: 09/423,554 Group: 1652
Filed: November 10, 1999 Examiner: Walicka
For: TRANSFORMED MICROORGANISMS WITH
IMPROVED PROPERTIES

REPLY TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, DC 20231

May 4, 2001

Sir:

In reply to the Restriction Requirement dated April 5, 2001, the following remarks are respectfully submitted in connection with the above-identified application.

REMARKS

Claims 1-38 are pending in the present application.

The Examiner has required election in the present application between:

Group I, claims 1-10, 17-22, 25, 26, 28-30, 33, and 38, drawn to an organism and methods of production of ethanol;

Group II, claims 1-7, 15-21, 25, 26, 28, 29, 31, and 32, drawn to an organism and methods of production of xyliol; and

Group III, claims 1-7, 11, 12, 17, 18, 23, 24, 27-30, 34, and 35, drawn to an organism and methods of production of lysine.

Group IV, claims 1-7, 13, 14, 17-20, 28, 29, 30, 36, and 37, drawn to an organism and methods of production of polyhydroxybutyrate.

For the purpose of examination of the present application, Applicants elect, with traverse, Group I, claims 1-10, 17-22, 25, 26, 28-30, 33, and 38.

The restriction requirement is strenuously traversed for the following reasons. It is believed that the restriction requirement is improper.

First, the groups in which the Examiner has placed the respective "inventions" all have a common single special technical feature that makes a contribution over the prior art. This special technical feature is a balancing of metabolic redox reactions in different metabolic processes in various organisms. The Applicants have shown that there is a single unified problem wherein NADH is reoxidized by respiratory processes. As such, there is one unified idea that can be solved by different processes. The multiple methods to which the Examiner refers in the Office Action of April 5, 2001 are all one coherent inventive idea that can simply be accomplished by several processes. Accordingly, it is believed

that the inventions are so linked as to define one single inventive concept. As such, the instant invention should not be broken up into separate "inventions".

Further, please see the attached document from Patent Practice, Conlin et al., ed. Kayton, Patent Resources Institute, Inc. Vol. 3, Fifth Edition, Washington DC. This publication enumerates

The Patent and Trademark Office has proposed amendments to 37 CFR §1.475, et seq., which adopt the unity of invention principles of PCT Article 13, for use by the Patent and Trademark Office when it acts in three situations: as International Searching Authority, as International Preliminary Examining Authority (under PCT, Chapter II) and during the national stage. This is already the law without those rules, however, under Caterpillar Tractor Co. v Comm'r, 650 F. Supp. 218, 231 (ED Va. 1986). Thus, while national applications are subject to regular U.S. restriction practice, national stage applications are subject instead to "unity of invention" rules of PCT Article 13.

Thus, because Applicants assert that there is single inventive concept and thus unity of invention for the reasons stated above, the restriction requirement should be withdrawn and the application should be examined as one invention.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gerald M. Murphy (Reg. No. 28,977) at the telephone number of the undersigned below, to conduct an interview

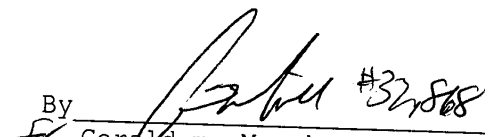
Appl. No. 09/423,554

in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #32868
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(Rev. 01/22/01)



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For: TRANSFORMED MICROORGANISM WITH IMPROVED
PROPERTIES

LARGE ENTITY TRANSMITTAL FORM

Assistant Commissioner for Patents
Washington, DC 20231

May 4, 2001

Sir:

Transmitted herewith is an amendment in the above-identified application.

- ☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.
- ☐ The enclosed document is being transmitted via facsimile.

The fee has been calculated as shown below:

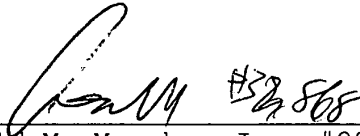
- ☐ Petition for () month(s) extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). \$0.00 for the extension of time.
- ☒ No fee is required.
- ☐ A check in the amount of \$0.00 is enclosed.
- ☐ Please charge Deposit Account No. 02-2448 in the amount of \$0.00. This form is submitted in triplicate.

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Respectfully submitted,

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ATTACHMENT

(Rev. 01/22/01)